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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,266

06/01/2005

Yasuo Tano

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EXAMINER

LAVERT, NICOLE F

ART UNIT

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3762

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,266	Applicant(s) TANO ET AL.	
	Examiner NICOLE F. LAVERT	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The "artificial vision system" as disclosed in the specification is not shown [(pp 5, ln 14) & (pp 6, ln 27)]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: In regards to the phrase, "...is implanted in a portion hided with," the words "hided with" should be changed to "hide by," (pp 7, ln 19). Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. The omitted structural cooperative relationships are: The claim is incomplete since no structure has been set forth to produce the stimulation pulses or generate the image as instantly claimed.

5. In regards to claim 7, line 4-5, the “primary” and “secondary” coils are inferentially included and it is unclear if the applicant is positively reciting these structures or functionally reciting the structures.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regards to claims 7-9 & 12, the phrases, “to be implanted in an eye”, and “to be implanted in the body” are directed to non-statutory subject matter because the claims positively recites a part of the human body. It is suggested to use language such as “adapted to be implanted” or “for implanting.”

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 7-12** are rejected under 35 U.S.C. 102(b) as being anticipated by Yagi et al. (US 2004/0102843).

For **claim 7**, Yagi et al. discloses, an artificial vision system comprising (Fig 1, 1): an image pickup device which is to be disposed outside a body of a patient and captures an image in front of the patient (Fig 1, 4); and a plurality of electrodes which are to be implanted in an eye of the patient so as to stick in an optic papilla of the eye (Fig 1, 11); the electrodes outputting an electric stimulation signal based on a signal for stimulation pulse which is generated based on the image captured by the image pickup device to stimulate an optic nerve of the eye, thereby enabling the patient to visually recognize the image captured by the image pickup device ([0053]-[0054]).

In regards to **claim 8**, Yagi et al. discloses, the artificial vision system according to claim 7 (Fig 1, 1), wherein the plurality of electrodes are to be implanted so as to individually stick in the optic papilla {[0059] & (Fig 5, 19 & N)}.

In regards to **claim 9**, Yagi et al. discloses, the artificial vision system according to claim 7 (Fig 1, 1), further comprising: an external device which is to be disposed outside the body and performs predetermined optimizing processing the image captured by the image pickup device to generate the signal for stimulation pulse; and an internal device which is to be implanted in the

body and converts the signal for stimulation pulse into the electrical stimulation signal to output the electrical stimulation signal from the electrodes {[0053]-[0054] & (Fig 1, 2, 3 & 11)}.

In regards to **claim 10**, Yagi et al. discloses, the artificial vision system according to claim 9 (Fig 1, 1), wherein the external device includes the image pickup device an image processing device which performs the predetermined optimizing processing to generate the signal for stimulation pulse, and a power supply {[0054]-[0055] & (Fig 2, 5 & 8)}.

In regards to **claim 11**, Yagi et al. discloses, the artificial vision system according to claim 10 (Fig 1, 1), wherein the image processing device adjusts parameters of the electrical signal to be outputted from the electrodes {[0010], [0054], [0058] & (Fig 2, 8)}.

In regards to **claim 12**, Yagi et al. discloses, the artificial vision system according to claim 9 (Fig 1, 1), wherein the signal and power are transmitted from the external device to the internal device by electromagnetic induction occurring between a primary coil which is to be attached to a skin of the body and a secondary coil which is to be implanted in the body {[0007], [0024] & (Fig 1, 10 & 12)}.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE F. LAVERT whose telephone number is (571)270-5040. The examiner can normally be reached on M-F 7:30-5:00p.m. (Alt. Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/
Primary Examiner, Art Unit 3762

/Nicole F. LaVert/
Examiner, Art Unit 3762